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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,682	12/30/2003	Roy Ben-Yoseph	10587.0474-00000	3174
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER TAHA, SHIAQ	
			ART UNIT 2478	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,682

Applicant(s)

BEN-YOSEPH, ROY

Examiner

SHAQ TAHA

Art Unit

2478

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 8, 10 - 14, 17 - 30, 35, 39 - 45, 47, and 49 - 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 8, 10 - 14, 17 - 30, 35, 39 - 45, 47, and 49 - 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Drafts/Person's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is a final action for application number 10/747,682 based on after a Non-final filed on 09/13/2010. The original application was filed on 12/30/2003. Claims 1 – 8, 10 – 14, 17 – 30, 35, 39 – 45, 47, and 49 - 55 are currently pending and have been considered below. Claims 9, 15, 16, 31 – 34, 36, 37, 38, 46 and 48 have been canceled. Claims 1, 23, and 35 have been amended. Claims 50 – 55 are new.

Response to Arguments

Applicant's arguments with respect to claims 1 – 8, 10 – 14, 17 – 30, 35, 39 – 45, 47, and 49 - 55 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims and 1 – 8, 10, 12 – 13, 17 – 30, 35, 39 – 45, 47, and 49 - 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Harms et al. (US 2003/0078981)

Regarding claim 1, 23, 45, 50, and 53, Friskel teaches a method of providing online presence information: maintaining, on one or more computer, a list of people that is known to a user, **[FIG. 6 illustrates an example of the contents of approved contacts file 116, which is the list of other members of messaging system 100 that have been selected by the sender using sender computer 106 as being approved contacts eligible to receive status information about the sender, wherein the contact list is maintained as shown in Fig. 1, Ref # 116, (Friskel et al., Col. 6, lines 28 - 35)],**

accessing, at one or more computer, the maintained list of people determined to be known to a user, **[Approved contacts file 116 is visible to the sender, but other information regarding such members is not accessible by the sender as shown in Fig. 1, Ref # 110 and 112 wherein a client contact list is shown, (Friskel et al., Col. 3, lines 56 – 60)],**

accessing, at one or more computer, online presence information for the user, **[Hidden contacts file 112 contains a list of messaging system members received from server 102 including the status information for each listed member as provided by server 102 as shown in Fig. 4, Ref # 114, (Friskel et al., Col. 4, lines 25 – 29)],**

determining, at one or more computer, a potential receiver of the online presence information, **[Hidden contacts file 112 corresponds to that portion of the members of messaging system 100 that have given the user of client computer 104 permission to receive their on-line status information as shown in Fig. 4 wherein the client as a potential receiver of the online presence of the contacts, (Friskel et al., Col. 3, lines 29 – 33)],**

comparing, at one or more computer, the potential receiver to the accessed list to determine if the potential receiver is included on the list, **[Visible contacts file 110 contains a list of aliases for those members of messaging system 100 that have been selected by the client user as being approved contacts eligible to receive status information about the client user as shown in Fig. 4, wherein the approved contact list has a potential receiver that is included on the list, (Friskel et al., Col. 3, lines 37 – 41)],**

and determining, at one or more computer, whether to communicate the online presence information to the potential receiver based on whether the potential receiver is included in the list, **[Approved contacts file 116 is stored on sender computer 106 and contains a list of aliases for members for which the sender using sender computer 106 has given permission to obtain on-line status information about the sender as shown in Fig. 5 wherein the approved contacts list and to communicate the online presence to the contact list, (Friskel et al., Col. 3, lines 50 – 55)],**

Friskel et al. fails to teach determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more

messages received by the user from the person, the actions including one or more of (1) saving the one or more messages from the person; (2) printing the one or more messages from the person; (3) moving the one or more messages from the person from an inbox to a folder; and (4) leaving the one or more messages from the person open for a predetermined period of time,

Harms et al. teaches the method automatically adds all contacts found in the inbox to the contact list, wherein the sender of the received messages that were open for a predetermined time and saved in an inbox will be added automatically to a contact list, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Friskel et al. by determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**.

Regarding claim 2 & 24, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining to not communicate the online presence information to the potential receiver when the potential receiver is not included in the list, **[Fig. 4, is receiver is not on list, online presence won't be communicated]**.

Regarding claims 3 & 25, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to an instant messaging application of the potential receiver, **[Fig. 1, Ref # 108, wherein an E-mail server is equivalent to instant messaging]**.

Regarding claims 4 & 26, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information on a web page, **[Fig. 3 shows an inbox which is a part of a webpage]**.

Regarding claims 5 & 27, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in member search results, **[Fig. 3, Ref # 304, wherein the search result is in the inbox]**.

Regarding claims 6 & 28, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to display the online presence information in a member profile, **[Fig. 4, Ref # 114]**.

Regarding claims 7 & 29, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver when a request for online presence information is received from the potential receiver, **[Fig. 1, arrows 118 correspond to communication between client computer 104 and server 102 for requesting and providing member information for hidden contacts file 112]**.

Regarding claims 8 & 30, Friskel teaches the method wherein determining whether to communicate the online presence information to the potential receiver comprises determining whether to communicate the online presence information to the potential receiver absent a request from the potential receiver for the online presence information, **[Fig. 4, Ref #114 wherein online status is available without request]**.

Regarding claim 10, Friskel teaches the method of claim 1 wherein the actions performed by the user on one or more messages received by the user from the person include saving an e-mail received from the person, **[The saved mail folder 420 represents a storage area in which the e-mail program stores e-mail selected by the user for storage in a folder other than the inbox folder 418, (Paragraph 29)]**.

Regarding claims 12, 21, and 43, Friskel teaches a method of providing online presence information: maintaining, on one or more computer, a list of people that is known to a user, **(Friskel et al., Col. 6, lines 28 - 35)**,

Friskel et al. fails to teach that the actions performed by the user on one or more messages received by the user from the person include moving an e-mail from a first folder to a second folder,

Harms et al. teaches the method automatically adds all contacts found in the inbox to the contact list, wherein the sender of the received messages that were open for a predetermined time and saved in an inbox will be added automatically to a contact list, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Friskel et al. by determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**.

Regarding claim 13, 35, 51, and 54, The method of claim 12 wherein the first folder is an inbox folder and the second folder is a folder other than a delete folder or a spam folder, **[Friskel et al., Fig. 3, Ref # 312, 314]**

Regarding claim 18, 40, 52, and 55, Friskel teaches that the method determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person includes detecting user actions that mitigate against factors that otherwise are used to infer a person is known to the user, **[Fig 6, Ref # 116]**.

Regarding claim 19 & 41, Friskel teaches the method wherein the user actions comprise the user taking steps to label a communication from the person as spam, **[Fig. 5, Ref # 110]**.

Regarding claim 17, 39, 47, and 49, the method wherein determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person further comprises inferring that a person is known to the user, wherein inferring comprises: accessing a contact list of the user to determine a first contact on the user's contact list, **[Fig. 4 shows a contact list wherein Sue is the first contact]**,

and accessing a contact list of the first contact to determine a second contact on the first contact's contact list, **[Fig. 4 shows a contact list wherein Sue is the first contact and Sue has her own contact list]**,

Regarding claim 22, 44, the method further comprising: enabling the user to expressly designate a person as known to the user, **[Fig. 4 shows an approved list of contacts that are designated as known to the user]**,

and adding the designated person to the list, **[Fig. 4 shows an added person to the list of contacts that are designated as known to the user]**.

Regarding claims 20 and 42, Friskel teaches a method of providing online presence information: maintaining, on one or more computer, a list of people that is known to a user, **(Friskel et al., Col. 6, lines 28 - 35)**,

Friskel et al. fails to teach that the method of claim 18 wherein the user actions comprise the user taking steps to add a person to a blacklist,

Harms et al. teaches the method automatically adds all contacts found in the inbox to the contact list, wherein the sender of the received messages that were open for a predetermined time and saved in an inbox will be added automatically to a contact list, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Friskel et al. by determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person, **(Harms et al., Paragraph 45)**, in order to add contacts received by email wirelessly, **(Harms et al., Paragraph 3)**.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Harms et al. (US 2003/0078981) and further in view of Koch et al. (US 2005/0086305)

Regarding claims 11, the modified Friskel teaches a method of providing online presence information: maintaining, on one or more computer, a list of people that is known to a user, **(Friskel et al., Col. 6, lines 28 - 35)**,

The modified Friskel et al. fails to teach determining that a person is known to the user based, at least in part, on one or more actions performed by the user on one or more messages received by the user from the person,

Koch et al. teaches that the method of claim 1 wherein the positive actions performed by the user on one or more messages received by the user from the person include printing an e-mail received from the person, **(Koch et al., Paragraph 9)**, in order to provides the capability to create, share and modify "common notes", **(Koch et al., Paragraph 10)**,

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the modified Friskel et al. by printing an e-mail received from the person, **(Koch et al., Paragraph 9)**, in order to provides the capability to create, share and modify "common notes", **(Koch et al., Paragraph 10)**.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Friskel et al. (US 6,839,737), in view of Harms et al. (US 2003/0078981) and further in view of Caghey et al. (US 2003/0212745)

Regarding claim 14, the modified Friskel teaches a method of providing online presence information: maintaining, on one or more computer, a list of people that is known to a user, **(Friskel et al., Col. 6, lines 28 - 35),**

the modified Friskel et al. fails to teach determining that the actions performed by the user on one or more messages received by the user from the person includes leaving an e- mail from the person open for a predetermined period of time,

Caghey et al. teaches if a tag in the form of a "new houses on the market" is announced, the user will probably be more interested and save the message for future reading or even open the message as soon as it is received, **(Caghey et al., Paragraph 87)**, in order classify the message as legitimate vs. junk, **(Caghey et al., Paragraph 9),**

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the modified Friskel et al. by including that the actions performed by the user on one or more messages received by the user from the person includes leaving an e- mail from the person open for a predetermined period of time, **(Caghey et al., Paragraph 87)**, in order classify the message as legitimate vs. junk, **(Caghey et al., Paragraph 9).**

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaq Taha whose telephone number is 571-270-1921. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Pwu can be reached on 571-272-6798.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

/S. T./

Examiner, Art Unit 2478

/Jeffrey Pwu/

Supervisory Patent Examiner, Art Unit 2478